

### **DETAILED ACTION**

1. Claims 1-16 have been examined. Application 10/671,500 (IMAGE RECORDING DEVICE, IMAGE RECORDING SYSTEM, IMAGE RECORDING METHOD, AND STORAGE MEDIUM FOR STORING IMAGE RECORDING PROGRAM) has a filing date 09/29/2003 and foreign priority 09/30/2002.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-4 are recited as system claims however, said claims do not recite any structure (i.e. apparatus). Regarding claim 14, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus).

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For example, claim 14 recites “selecting at least one of the multiple pieces of advertisement information” but does not mention what apparatus is doing the selection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite “positional information from at which advertisement information is recorded”. For purpose of art rejection, said limitation would be interpreted a simply meaning an URL address of an advertisement. Also, claims 1-4 are indefinite because said system claims do not recite any structure (i.e. apparatus).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Landress (US 2003/0191816).

Claim 1, Landress teaches:

An information recording device comprising:

a selecting portion which selects at least one piece of advertisement information from multiple pieces of advertisement information or at least one piece of positional information from multiple pieces of positional information each representing a position at which the advertisement information is recorded, based on at least one of image data obtained by photographing an object (see paragraph 108), photographing information representing a situation in which the object was photographed, and personal information of an orderer who places an order for recording of the image data on a recording medium (see paragraphs 106-108); and

a recording portion which records the image data on the recording medium and records the selected information on empty space of the recording medium (see paragraph 147).

Claim 2, Landress teaches:

wherein the photographing information includes at least one of a location and a date of photographing (see paragraphs 106-108).

Claim 3, Landress teaches:

wherein the advertisement information or the positional information is selected based on the object included in the image data (see paragraph 119).

Claim 4, Landress teaches:

wherein the positional information represents a position on a network at which the advertisement information is recorded (see paragraph 116 “links to sponsor’s sites”).

Claim 5, Landress teaches:

An information recording system comprising:

a transmission device for transmitting via a network image data obtained by photographing an object and order information for recording the image data onto a recording medium, the order information including personal information of an orderer (see paragraphs 32 and 119);

an advertisement database connected to the network, the advertisement database having recorded therein in advance multiple pieces of advertisement information or multiple pieces of positional information each representing a position where the advertisement information is recorded (see paragraphs 106-108); and

an information recording device connected to the network, the information recording device recording on the recording medium image data transmitted from the transmission device and recording selected information on empty space of the recording medium, wherein, in the information recording device or the advertisement database, the information to be recorded on the empty space is selected from at least one of the multiple pieces of advertisement information or the multiple pieces of positional information based on at least one of the image data transmitted from the transmission device via the network and the personal information (see paragraphs 106-108).

Claim 6, Landress teaches:

an advertisement information providing device which includes a recording medium having the advertisement information recorded thereon and provides to the advertisement database at least one of the advertisement information and the positional

information representing the position where the advertisement information is recorded (see paragraphs 106-108).

Claim 7, Landress teaches:

wherein the advertisement information providing device is connected to the network, and the advertisement database transmits charging information to the advertisement information providing device (see paragraph 139).

Claim 8, Landress teaches:

wherein the positional information represents a position on the network where the advertisement information is recorded (see paragraph 116).

Claim 9, Landress teaches:

An information recording system comprising:

a transmission device for transmitting via a network image data obtained by photographing an object, photographing information representing a situation in which the object was photographed (see paragraph 108), and order information for recording the image data onto a recording medium, the order information including personal information of an orderer (see paragraph 119);

an advertisement database connected to the network, the advertisement database having recorded therein in advance multiple pieces of advertisement information or multiple pieces of positional information each representing a position where the advertisement information is recorded (see paragraphs 106-108); and

an information recording device connected to the network, the information recording device recording on the recording medium image data transmitted from the transmission device and recording selected information on empty space of the recording medium (see paragraph 147),

wherein, in the information recording device or the advertisement database, the information to be recorded on the empty space is selected from at least one of the multiple pieces of advertisement information or the multiple pieces of positional information based on at least one of the image data transmitted from the transmission device via the network, the photographing information representing the situation in which the object was photographed, and the personal information (see paragraphs 106-108).

Claim 10, Landress teaches:

a personal information database connected to the network and having recorded therein at least one of the personal information included in the order information and personal information that the orderer has registered in advance, wherein, when the advertisement information or the positional information is selected based on the personal information in the information recording device or in the advertisement database, the advertisement information or the positional information is selected based on the personal information provided from the personal information database (see paragraph 119).

Claim 11, Landress teaches:

an advertisement information providing device which includes a recording medium having the advertisement information recorded thereon and provides to the advertisement database at least one of the advertisement information and the positional information representing a position where the advertisement information is recorded (see paragraph 116).

Claim 12, Landress teaches:

wherein the advertisement information providing device is connected to the network, and the advertisement database transmits charging information to the advertisement information providing device (see paragraph 139).

Claim 13, Landress teaches:

wherein the positional information represents a position on the network where the advertisement information is recorded (See paragraph 116).

Claim 14, Landress teaches:

An image recording method comprising:

selecting at least one of multiple pieces of advertisement information or at least one of multiple pieces of positional information each representing a position at which the advertisement information is recorded based on at least one of image data obtained by photographing an object (see paragraph 108), photographing information representing a situation in which the object was photographed, and personal information of an orderer who places an order for recording of the image data on a recording medium (see paragraphs 106-108); and

recording the image data on the recording medium and recording the selected information on empty space of the recording medium (see paragraph 147).

Claim 15, Landress teaches:

recording the multiple pieces of advertisement information or the multiple pieces of positional information in the advertisement database in advance (see paragraphs 71-73).

Claim 16, Landress teaches:

A storage medium which has stored thereon an information recording program for making a computer execute a predetermined process, the predetermined process comprising:

selecting at least one of multiple pieces of advertisement information or at least one of multiple pieces of positional information based on at least one of image data obtained by photographing an object (see paragraph 108), photographing information representing a situation in which the object was photographed, and personal information of an orderer who places an order for recording of the image data on a recording medium (see paragraphs 106-108); and

recording the image data on the recording medium and recording the selected information on empty space of the recording medium (see paragraph 147).

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
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